



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,522	04/06/2005	Norbert Heske	289-PDD-03-08 US	6406
96000	7590	10/07/2010	EXAMINER	
C. R. Bard, Inc. Bard Biopsy Systems 1415 W. 3rd St. Tempe, AZ 85281			LLOYD, EMILY M	
			ART UNIT	PAPER NUMBER
			3736	
			NOTIFICATION DATE	DELIVERY MODE
			10/07/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

BPVIP.Docket@crbard.com

Jacki.Daspi@crbard.com

raust@austiplaw.com

Office Action Summary

Application No.

10/500,522

Applicant(s)

HESKE ET AL.

Examiner

EMILY M. LLOYD

Art Unit

3736

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 96-143 is/are pending in the application.
- 4a) Of the above claim(s) 97-110 and 116-143 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 96 and 111-115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date 20100716
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The Examiner acknowledges Applicant's amendments to the specification and claims 96 and 111-114. Currently, claims 96-143 are pending, and claims 97-110 and 116-143 are withdrawn.

Information Disclosure Statement

The Examiner notes that the kind code, issue date, and Name of Patentee or Applicant do not match the Patent Number for Cite No 1 of Applicant's 16 July 2010 IDS. The Examiner has updated the kind code, issue date, and Name of Patentee or Applicant based on the Patent Number provided by Applicant. However, as the Patent Number provided is to a gas burner, it is unclear if Applicant intended to cite this reference.

Specification

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously

incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

The amendment filed 9 May 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the incorporation by reference of documents not previously incorporated by reference (see [0001]).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 111-115 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 111, it is unclear what a "secondary transmission" defines. It is unclear if this is a transmission that operates when a primary transmission is not moving, that operates when a primary transmission is unable to move, that is smaller than a primary transmission, and/or another definition. Claims 112-115 are rejected as ultimately depending on claim 111.

Regarding claim 112, it is unclear what limitation(s) this claim adds to claim 111, as this limitation appears to already be in amended claim 96. Claims 113-115 are rejected as ultimately depending on claim 112.

Regarding claim 113, it is unclear if the "double-arm level configured to mechanically lock the tension slide in the cocked position" is the same structure as "the tension slide being locked in the cocked position by a releasable locking mechanism" or another structure; further, if it is another structure, it is unclear if the different structures are intended to work together, work at different times, and/or otherwise how and if the different structures interact.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 96 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4989614 (Dejter).

Dejter discloses a biopsy device for taking tissue samples (Figures 13-16), comprising: a housing (casing 1 Figure 13) containing an electric power source (battery 92 Column 12 lines 9-11) and a tension slide (syringe carriage 40 Figure 13) connected to the power source, wherein the tension slide is brought into a cocked position against the action of a first spring (either of springs 61 Figure 16; the Examiner notes that

"comprising" in this claim allows for more than one spring) by the power source (see entire document, including Column 13 line 54-Column 14 line 6), the tension slide being locked in the cocked position by a releasable locking mechanism (main solenoid 70 is able to lock and release the tension slide at and from Position "B", Figures 1B and 1C and Column 13 line 54-Column 14 line 13; alternatively, detent 65 and detent solenoid 66 Column 13 line 54-Column 14 line 13 and Column 14 lines 50-54 keep the tension slide biased against the force of spring 61); a removable element (Column 11 lines 5-7) configured for insertion into the housing, comprising: a biopsy needle unit, comprising a hollow biopsy needle (needle 2 Figure 13), having a sample removal chamber (sample storage portion 20 of needle 2 Figure 13), and a cutting sheath (sheath 6 Figure 13), wherein the biopsy needle unit is arranged on the tension slide (syringe carriage 40 Figure 13); a vacuum pressure-generating device (syringe carriage 40 and plunger support bracket 45 moving plunger 5 with respect to syringe 4, Figure 13); and a connection element connecting the biopsy needle unit and the vacuum pressure-generating device (luer-lock connections 18, 31 Figure 13 and Column 10 lines 16-18); and a control panel attached to the housing (electronic control circuit 109 Figure 13).

Terminal Disclaimer

The terminal disclaimer filed on 16 July 2010 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on application number 11/680882 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

Applicant's arguments filed 16 July 2010 have been fully considered but they are not persuasive.

Regarding Dejter, the Examiner notes that a cutting sheath can be a sheath for cutting tissue or a sheath for covering a cutter. As noted in the "Election/Restrictions" portion of the prior Office Action, Dejter teaches the latter.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a sheath that cuts" (or a sheath configured to cut tissue)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding Applicant's arguments that Dejter does not disclose "the tension slide being locked in the cocked position by a releasable locking mechanism", the Examiner disagrees. The Examiner notes that two alternative interpretations of a "releasable locking mechanism" are provided above. The Examiner further notes that Applicant's citation of Column 14 lines 33-38 of Dejter is unrelated to one interpretation (if position "B" as described in Column 13 line 54-Column 14 line 13 is defined as the cocked position), and is still referring to a "cocked position" if any compression of the spring(s) 61 is considered to have the device in a cocked position, as compression of the

spring(s) 61 is not released until the carriage is returned position "A" as described in Column 14 lines 48-54 and Figure 1a.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **EMILY M. LLOYD** whose telephone number is (571)272-2951. The examiner can normally be reached on Monday through Friday 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Emily M Lloyd
Examiner
Art Unit 3736

/EML/

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736